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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 8

Application Number: 09/186,741
Filing Date: November 5, 1998
Appellant(s): Harry W. Eberle, III

Kenneth P. Glynn
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed April 18, 2000.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

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(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 18-29 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

2,362,252	ELLINWOOD	11-1944
5,529,428	BISCHOF	6-1996
Germany 372,483	WOTHE	3-1923

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. Claims 27-29 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As concerns claim 27, the phrases “said at least two vertical support members”, in line 10, and “and one of each being located on opposite sides of an attachment orifice”, in lines 11-12, lack antecedent basis because “at least one...vertical support member”, in line 6, is being claimed, therefore the claim is rendered vague and indefinite. Furthermore, there are two periods within the claim (i.e., lines 15 and 17) which is improper.

Claim Rejections - 35 USC § 103

2. Claims 18, 19, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellinwood in view of Bischof 5,529,428.

As concerns claim 18, Ellinwood sets forth an anchoring biscuit device comprising a first substantially flat horizontal top element having a generally biscuit-shaped top view configuration (inclusive of members 25) with opposite side walls and a center area therebetween; at least two substantially vertical support member (inclusive of the two vertical halves of member 24) attached

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to the underside of the top member and extending downward therefrom for a predetermined length and being substantially flat; and at least one attachment orifice (inclusive of member 30) located on at least the top element. What **Ellinwood does not set forth** is the side walls of the top element each being in the shape of an arc having a radii and an arc length. However, **Bischof teaches** forming the side walls of a connector piece (such as an anchoring biscuit and best illustrated in figure 9) as being in the shape of an arc having a radii and an arc length. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the side walls of Ellinwood by forming them as having an arc having a radii and an arc length, as taught by Bischof, in order to decrease the friction between the biscuit and the attached elements and thereby increase the ease as to which the biscuit can be initially set into place.

As concerns claim 19, Ellinwood sets forth the attachment orifice being at least one screw hole (viewed as such since a screw can extend through the hole).

As concerns claims 24 and 26, Ellinwood sets forth the top element and the vertical support member are uni-structurally formed.

As concerns claim 25, Ellinwood sets forth the two vertical support members being located opposite one another and on each side of the orifice.

As concerns claim 27, Ellinwood sets forth the biscuit, as advanced above, including a single vertical support member being located off center and to one side of the attachment orifice (best illustrated in Figures 2-4).

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3. Claims 20-23, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellinwood in view of Bischof further in view of German Patent 372,483.

Ellinwood in view of Bischof set forth the anchoring biscuit except for the attachment orifice having a beveled top, and being non-circular and elongated. However, German Patent 372,483 teaches an anchoring device, inclusive of members d and e, having a beveled top, and being non-circular and elongated. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the attachment orifice of Ellinwood in view of Bischof by forming it having a beveled top, and being non-circular and elongated, as taught by German Patent 372,483, in order to increase the friction between the head of an attachment screw and the attachment orifice, and to allow the alignment of the attachment screw to be adjusted to thereby increase the strength of the connection between the anchoring biscuit and the adjoined boards.

(11) Response to Argument

As concerns remarks pertaining to the structure of Ellinwood, the examiner stands by the position that Ellinwood sets forth structural elements, as advanced in the outstanding rejections, that fall within the limitations set forth by the applicant in the instant claims except for the side walls of the top element each being in the shape of an arc having a radii and an arc length; and the attachment orifice having a beveled top, and being non-circular and elongated. However, these

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limitations can be found within the relevant prior art and can be used as teaching references, also as advanced in the outstanding rejections.

The phrase "biscuit-shaped" is known in the art, however, exact geometric dimensions are not, and since the overall geometric shape of Ellinwood is very similar to the geometric shape of the instant invention, the examiner takes the position that the anchoring element of Ellinwood can also be considered as "biscuit-shaped".

As concerns the stated orifices, the examiner reiterates the position that when in use, i.e., the final product, the attachment member (28) passes through opening 31 and continues to pass all the way through the device thereby completing the attachment orifice as passing all the way through the device (further illustrated as such in Figures 1-4). The examiner takes the position that how the orifice was first formed is of little consequence to the patentability of the device, itself, because Ellinwood clearly possesses an orifice. Note that one need only remove the nail 28 to verify this.

As concerns remarks pertaining to grooves within the panels being connected by the anchoring biscuit, the examiner takes the position that the panels of the instant invention are not set forth as being part of the invention and therefore cannot be considered as a structural limitation influencing the patentability of the instant anchoring biscuit over the prior art of record. Further, the examiner points out that the anchoring biscuit of Ellinwood are shaped and sized to be received within respective grooves of the adjacent panels and function to hold them together as does the anchoring biscuit of the instant invention.

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As concerns remarks pertaining to the reference of Bischof, the examiner reiterates the position that Bischof teaches forming side walls of a connector piece (such as illustrated in Figures 1, 2, 4-7, and 9) as being in the shape of an arc having a radii and an arc length that will result in a decrease in friction between the connector piece and grooves of the elements being connected and thereby increase the ease as to which the biscuit can be initially set into place. Therefore, it would have been obvious to modify the side walls of Ellinwood by forming them as having an arc having a radii and an arc length, as taught by Bischof, in order to decrease the friction between the biscuit and the attached elements and thereby increase the ease as to which the biscuit can be initially set into place.

As concerns the remarks that the connector of Bischof, as illustrated in Figure 9, has separate functions and uses, the examiner points out that the side walls of this particular connector piece does incorporate the shape of an arc having a radii in order to decrease the friction between the element and the respective elements it is being used upon. Furthermore, the reference of Bischof also sets forth a connector (illustrated in Figures 1, 2, and 4-7) that performs similar functions with comparison to the instant anchoring biscuit and incorporates side walls being in the shape of an arc having a radii and an arc length that will result in a decrease in friction between the connector piece and grooves of the elements being connected and thereby increase the ease as to which the biscuit can be initially set into place.

As concerns remarks pertaining to the combination of the German patent '483 with Ellinwood and Bischof. The examiner reiterates the position that it would have been obvious to

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modify the attachment orifice of Ellinwood in view of Bischof by forming it having a beveled top, and being non-circular and elongated, as taught by '483, in order to increase the friction between the head of an attachment screw and the attachment orifice, and to allow the alignment of the attachment screw to be adjusted to thereby increase the strength of the connection between the anchoring biscuit and the adjoined boards.

As concerns remarks pertaining to the reference of Ellinwood not using screws, the applicant should again note that since a fastener or fastener type is not being set forth as part of the invention, arguments pertaining to the type of fastener being used by the reference of Ellinwood is not persuasive. Furthermore, whether or not Ellinwood sets forth the use of screws, the connection between the anchor and the respective panels would also be improved when nails are used and driven into the anchor.

As concerns remarks pertaining to the 132 affidavit, the attachments, and conclusions, the examiner points out that no evidence (i.e., sales data, percent of the market share) has been set forth proving the "commercial success" as stated by the applicant. See In re Huang, 100 F.3d 135, 137, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); Cable Elec. Prods., Inc. v. Genmark Inc., 770 F. 2d 1015, 1026-27, 226 USPQ 881, 888 (Fed. Cir. 1985), and others, which establish that sales are a direct result of unique characteristics of the claimed invention as opposed to other commercial and economic factors unrelated to the quality. Further, the applicant remains silent with respect to evidence establishing a nexus between the claimed invention and the asserted commercial success. Furthermore, the "EB-TY" product, as presented by the applicant, has not

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been defined nor its probative value discerned. Finally, the applicant has not set forth any objective evidence pertaining to any "long felt need" that an art recognized problem existed for a long period of time without solution. Thus, the need must have been a persistent one that was recognized by those of ordinary skill in the art. See In re Gershon, 372 F. 2d 535, 539, 152 USPQ 602, 605 (CCPA 1967).

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Patent Examiner

bl

April 27, 2000

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